

Office Action Summary	Application No. 10/568,358	Applicant(s) ASPLAND, MARK	
	Examiner JIANCHUN QIN	Art Unit 2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/03/09&04/25/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-71 is/are pending in the application.
- 4a) Of the above claim(s) 51-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 48-50 and 71 is/are allowed.
- 6) ☒ Claim(s) 44-47 and 70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20090507</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 51-69 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

The newly submitted claims 51-69 are directed to inventions that are related to the originally presented invention as combination (originally presented invention) and subcombination (new claims 51-69).

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination does not necessarily require the particulars of the subcombination as claimed, such as “means to activate the beater to repeatedly beat against a surface of a wall at said interior, said means including a cable outside the box and extending toward a box wall, the cable operatively connected to the beater in the box” (in claim 51) or “wherein there are three of said outer surface portions which, when impacted, produce three different sounds” (in claim 53) or “wherein a wall of the box has different outer surface portions located to be selectively manually impacted” (in claim 61) or “wherein there are three of said outer surface portions which, when impacted, produce three different sounds” (in claim 62) or “wherein said means include a rotary shaft outside the box and extending toward said one box wall, and operatively connected to the beater” (in claim 64) or “means including

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a flexible extendable member outside the box and extending toward a box wall, the flexible extendable member operatively connected to the beater in the box” (in claim 69). The subcombination has separate utility such as: coupling the beater to an foot pedal external to the resonant chamber (see US7365258, Figs. 2 and 4), or providing a surface consisting of multiple sections which differ in such manner that different quality sounds are produced when such sections are selectively manually impacted (see US7365258, Figs. 2; col. 2, lines 5-15 and lines 22-27), or providing a rotary shaft outside the chamber for effecting rotation of the beater, as by foot activation of a driver unit (see US7365258, Fig. 1), respectively.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, recognized divergent subject matter, and different search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 51-69 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objection

2. Claims 44-71 are objected to because of the following informalities:

In the listing of claims filed 04/25/09, please remove the comment statement “*The Examiner is advised that new Claims 51-69 were copied on March 3, 2009, from Lombardi, U.S. Patent No. 7,365,258 B1, issued April 29, 2008, for the purpose of provoking an interference proceeding.*” on page 2, the comment statement “*The Examiner is advised that new independent Claim 69 is based upon independent Claim 1 from Lombardi, U.S. Patent No. 7,365,258 B1, issued April 29, 2008, and is presented for the purpose of provoking an interference proceeding:*” on page 7, and the comment statement “*The Examiner is advised that new dependent Claims 70 and 71, which are made dependent upon independent Claims 44 and 48, respectively, recite a preferred embodiment of Applicant's invention and are not based upon the claims patented in Lombardi, U.S. Patent No. 7,365,258 B1, issued April 29, 2008:*” on page 8, respectively. Applicant is advised to make any comments regarding newly submitted amendments in the Remark section of the response.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 44-47 and 70 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

In claim 44, the phrases "being able to" render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claims 45-47 and 70 are rejected based on dependency.

Allowable Subject Matter

5. Claims 44-47 and 70 would be allowable if rewritten to overcome the rejection set forth in sections 3 and 4 above in this Office Action.
6. Claims 48-50 and 71 are allowed.

Reasons for Allowance

7. The following is a statement of reasons for the indication of allowable subject matter:

Please see Applicant's responses with respect to claims 44-50, 70 and 71 received 03/03/09 and 04/25/09 and the Office action mailed 12/03/08 for reasons for allowance.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

9. Applicant's arguments with respect to claims 51-69 have been fully considered but they are not persuasive.

Newly submitted claims 51-69 are directed to inventions that are independent or distinct from the invention originally claimed as discussed above, therefore, are subject to a restriction requirement. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 51-69 are withdrawn from consideration as being directed to a non-elected invention.

Applicant's arguments with respect to claims 44-50, 70 and 71 are deemed to be persuasive. Allowable subject matters recited in these claims are identified as set forth in sections 4-6 above.

Contact Information

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jianchun Qin whose telephone number is (571) 272-5981. The examiner can normally be reached on 8am - 5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on (571) 272-1990.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JIANCHUN QIN/

Examiner, Art Unit 2832